

REMARKS:

Claims 30-53 are currently pending in the application.

Claims 1-29 were previously canceled without *prejudice*.

Claim 54 is currently canceled without *prejudice*.

Claims 30, 38, 46, and 54 stand objected to due to various informalities.

Claims 46-53 stand rejected under 35 U.S.C. § 101.

Claims 30-54 stand rejected under 35 U.S.C. § 112, second paragraph.

Claims 30-32, 34-40, 42-48, and 50-54 stand rejected under 35 U.S.C. § 103(a) over U.S. Publication No. 2002/0032637 to Moshal *et al.* (hereinafter “*Moshal*”) in view of the Examiner’s Official Notice. Claims 33, 41, and 49 stand rejected under 35 U.S.C. § 103(a) over *Moshal* in view of U.S. Publication No. 2002/0194104 to Reamer (hereinafter “*Reamer*”) further in view of the Examiner’s Official Notice.

Applicant respectfully submits that all of Applicant’s arguments and amendments are without *prejudice* or *disclaimer*. In addition, Applicant has merely discussed example distinctions from the cited prior art. Other distinctions may exist, and as such, Applicant reserves the right to discuss these additional distinctions in a future Response or on Appeal, if appropriate. Applicant further respectfully submits that by not responding to additional statements made by the Examiner, Applicant does not acquiesce to the Examiner’s additional statements. The example distinctions discussed by Applicant are considered sufficient to overcome the Examiner’s rejections. In addition, Applicant reserves the right to pursue broader claims in this Application or through a continuation patent application. No new matter has been added.

I. Claim Objections

Claims 30, 38, 46, and 54 stand objected to due to various informalities. While Applicant respectfully submits that these claims are allowable in their prior, unamended form, Applicant

further respectfully submits that current amendments to Claims 30, 38, and 46 and the cancellation of Claim 54 without prejudice renders moot the Examiner's informalities objections. As such, Applicant respectfully requests that the Examiner's objections to Claims 30, 38, and 46 be withdrawn.

II. Rejections Under 35 U.S.C. § 101

Claims 46-53 stand rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. While Applicant respectfully submits that in their unamended form, Claims 46-53 are directed toward statutory subject matter, to expedite prosecution and timely issuance of the Subject Application, Applicant has amended Claims 46-53 thereby rendering moot the Examiner's rejections under 35 U.S.C. § 101 and respectfully request that these rejections be withdrawn.

III. Rejections Under 35 U.S.C. § 112, Second Paragraph

Claims 30-54 stand rejected under 35 U.S.C. § 112, second paragraph. Applicant respectfully disagrees.

Nonetheless, Applicants respectfully submits that Applicant has amended Claims 30, 36-38, and 46-53 and canceled Claim 54 without prejudice to more distinctly claim that which Applicant regards as the invention. As such, Applicant respectfully requests that the Examiner's rejections under 35 U.S.C. § 112 be withdrawn.

IV. Rejections Under 35 U.S.C. § 103(a)

Claims 30-32, 34-40, 42-48, and 50-54 stand rejected under 35 U.S.C. § 103(a) *Moshal* in view of the Examiner's Official Notice. Claims 33, 41, and 49 stand rejected under 35 U.S.C. § 103(a) over *Moshal* in view of *Reamer* further in view of the Examiner's Official Notice. Applicant respectfully disagrees.

Applicant respectfully submits that Claims 30-53 in their current form contain unique and novel limitations that are not disclosed by *Moshal*, *Reamer*, or the Examiner's Official Notice

whether taken individually or in combination. Thus, Applicant respectfully submits that Claims 30-53 are not rendered obvious by the proposed combination of *Moshal*, *Reamer*, and the Examiner's Official Notice and respectfully traverses the Examiner's rejection of these claims under 35 U.S.C. § 103(a). Applicant further respectfully submits that Claims 30-53 are in condition for allowance. Thus, Applicant respectfully requests that Claims 30-53 be allowed.

The Examiner notes that *Moshal* fails to disclose the following elements of Applicant's claims:

a buyer request display comprising one or more patterns representing the buyer request, the one or more patterns of the buyer request comprising a plurality of bars, each bar representing a particular buyer offer variable and comprising a set of one or more geometric display elements, wherein the buyer computer encodes the value of the particular one of the plurality of buyer offer variables, according to a predefined encoding scheme; and

an offers display of the one or more offers, the offers display comprising a plurality of patterns, each pattern of the plurality of patterns representing a particular one of the one or more offers and comprising a plurality of bars, each bar representing a particular one of the plurality of seller offer variables and comprising a set of one or more geometric display elements, wherein the buyer computer encodes the value of the particular one of the plurality of seller offer variables, according to the predefined encoding scheme;

(6 July 2009 Final Office Action, page 10). However, Applicant respectfully submits that not only does Reamer fail to disclose these missing elements, the Examiner also fails to appropriately point to any portions of specific documentary evidence to properly support the Examiner's Official Notice to fill the gaps in the limitations noted above that *Moshal* fails to provide.

A. The Examiner's Official Notice is Improper under MPEP § 2144.03

Applicant respectfully submits that Applicant is confused as to what the Examiner teaches by the Official Notice or even to the extent in which the Examiner is taking Official Notice. Applicant respectfully requests clarification as to the subject matter for which Official Notice is being taken. *Applicant respectfully traverses the Official Notice because the asserted facts*, as best

understood by Applicant, appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight.

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection." (MPEP § 2144.03). "Official notice unsupported by documentary evidence *should only be taken by the examiner* where the facts asserted to be well-known, or to be common knowledge in the art are *capable of instant and unquestionable demonstration as being well-known*."

With respect to the subject Application, the Examiner's states the following:

Official Notice is taken that it was old and well-known at the time of the invention to provide a buyer request display comprising one or more patterns representing the buyer request, the one or more patterns of the buyer request comprising a plurality of bars, each bar representing a particular buyer offer variable and comprising a set of one or more geometric display elements, wherein the buyer computer encodes the value of the particular one of the plurality of buyer offer variables, according to a predefined encoding scheme; and an offers display of the one or more offers, the offers display comprising a plurality of patterns, each pattern of the plurality of patterns representing a particular one of the one or more offers and comprising a plurality of bars, each bar representing a particular one of the plurality of seller offer variables and comprising a set of one or more geometric display elements, wherein the buyer computer encodes the value of the particular one of the plurality of seller offer variables, according to the predefined encoding scheme;

Examiner notes, that the display represents a user interface. It was old and well known at the time of the invention that a user interface provides for the presentation of information to the users and the capture of their inputs.

[I]t was old and well-known at the time of the invention to manipulate the presentation of the information in a variety of ways in accordance with the preferences of a particular user. These presentations included the use of patterns incorporating bars, columns, grids etc. For example, Excel programs have been used frequently in reports, slide shows and presentations to show diagrams in the form of bars, lines and other visual forms.

Official Notice is taken that it is old and well-known for buyers and sellers to limit their business transactions to preferred parties. Specifically, it was old and well known to provide wherein the one or more offers comprise asks only from sellers computers on an approved vendor list (AVL).

(6 July 2009 Final Office Action, pages 11-17). Applicant respectfully submits that the Examiner's statements as shown above ***are not capable of instant and unquestionable demonstration as being well-known***. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is ***never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record***, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002)." (MPEP § 2144.03(A)).

"Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that ***general conclusions concerning what is "basic knowledge" or "common sense" to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection***). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made." (MPEP § 2144.03(B)). (Emphasis Added).

Thus, if the Examiner continues to reject Applicant's claims based on the Official Notice, Applicant respectfully requests that the Examiner provide appropriate documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, Applicant further respectfully requests

that the Examiner provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

B. The Office Action Fails to Properly Establish a *Prima Facie* case of Obviousness over the Proposed *Moshal-Reamer*-Official Notice Combination According to the UPSTO Examination Guidelines

Applicant respectfully submits that the Office Action fails to properly establish a *prima facie* case of obviousness based on the proposed combination of *Moshal*, *Reamer* and the Examiner's Official Notice, and in particular, the Office Action fails to establish a *prima facie* case of obviousness based on the "Examination Guidelines for Determining Obviousness Under 35 U.S.C. 103 in View of the Supreme Court Decision in *KSR International Co. v. Teleflex Inc.*" (the "Guidelines").

As reiterated by the Supreme Court in *KSR International Co. v. Teleflex Inc.* (*KSR*), the framework for the objective analysis for determining obviousness under 35 U.S.C. 103 is stated in *Graham v. John Deere Co.* (383 U.S. 1, 148 USPQ 459 (1966)). Obviousness is a question of law based on underlying factual inquiries. These factual inquiries enunciated by the Court are as follows:

- (1) Determining the scope and content of the prior art;
- (2) Ascertaining the differences between the claimed invention and the prior art; and
- (3) Resolving the level of ordinary skill in the pertinent art.

(Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). Objective evidence relevant to the issue of obviousness must be evaluated by Office personnel. (383 U.S. 17–18, 148 USPQ 467 (1966)). As stated by the Supreme Court in *KSR*, "While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls." (*KSR*, 550 U.S. at ___, 82 USPQ2d at 1391).

However, it is important to note that the Guidelines require that Office personnel "***ensure that the written record includes findings of fact*** concerning the state of the art and the teachings of the references applied. (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). In addition, the Guidelines remind Office personnel that the "***factual findings made by Office personnel are the necessary***

underpinnings to establish obviousness.” (id.). Further, “Office personnel must provide an explanation to support an obviousness rejection under 35 U.S.C. 103. (id.). In fact, “35 U.S.C. 132 requires that Applicant be notified of the reasons for the rejection of the claim so that he or she can decide how best to proceed” and “clearly setting forth findings of fact and the rationale(s) to support a rejection in an Office action leads to the prompt resolution of issues pertinent to patentability.” (id.).

With respect to the subject application, the Office Action has not shown the *factual findings necessary to establish obviousness* or even *an explanation to support the obviousness rejection* based on the proposed combination of *Moshal*, *Raemer*, and the Examiner’s Official Notice. The Office Action merely states that “it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the teachings of *Moshal* by adopting the teachings of *Raemer* to provide system/method/software, wherein the user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL).” (6 July 2009 Final Office Action, page 17). Applicant respectfully disagrees and respectfully submits that the Examiner’s conclusory statement is not sufficient to establish the *factual findings necessary to establish obviousness* and is not a sufficient *explanation to support the obviousness rejection* based on the proposed combination of *Moshal*, *Raemer*, and the Examiner’s Official Notice. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including the factual findings necessary to establish obviousness to “ensure that the written record includes findings of fact concerning the state of the art and the teachings of the references applied.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines further provide guidance to Office personnel in “determining the scope and content of the prior art” such as, for example, “Office personnel must first obtain a thorough understanding of the invention disclosed and claimed in the application.” (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)). The scope of the claimed invention must be clearly determined by giving the claims the “broadest reasonable interpretation consistent with the specification.” (See *Phillips v. AWH Corp.*, 415 F.3d 1303, 1316, 75 USPQ2d 1321, 1329 (Fed. Cir. 2005) and MPEP § 2111.). In addition, the Guidelines state that any “*obviousness rejection should include*, either explicitly or implicitly in view of the prior art applied, *an indication of the level of ordinary skill.*” (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). With respect to the subject Application, the Office Action has

not provided *an indication of the level of ordinary skill*. *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including an indication of the level of ordinary skill, relied upon by the Examiner.* (Notice, 72 Fed. Reg. 57527 (Oct. 10, 2007)).

The Guidelines still further provide that once the *Graham* factual inquiries are resolved, Office personnel must determine whether the claimed invention would have been obvious to one of ordinary skill in the art. (*Id.*). For example, the Guidelines state that ***Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.*** (*Id.*). In addition, the Guidelines state that the proper analysis is *whether the claimed invention would have been obvious to one of ordinary skill in the art after consideration of all the facts.* (*Id.* and *See* 35 U.S.C. 103(a)).

With respect to the subject Application, the Office Action has not expressly resolved any of the *Graham* factual inquiries to determine whether Applicant's invention would have been obvious to one of ordinary skill in the art. In addition, the Office Action fails to ***explain why the differences between the proposed combination of Moshal, Reamer, and the Examiner's Official Notice and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** The Office Action merely states that "one would have been motivated to avoid fraud, maintain business related and facilitate a more efficient experience." (6 July 2009 Final Office Action, page 17). Applicant respectfully disagrees and further respectfully requests clarification as to how this statement ***explains why the difference(s) between the proposed combination of Moshal, Reamer, and the Examiner's Official Notice, and Applicant's claimed invention would have been obvious to one of ordinary skill in the art.*** Applicant further respectfully submits that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

The Guidelines yet further state that the "key to supporting *any* rejection under 35 U.S.C. 103 is the *clear articulation of the reason(s) why the claimed invention would have been obvious.*" (Notice, 72 Fed. Reg. 57528 (Oct. 10, 2007)). In fact, the Supreme Court in *KSR* noted that "*the analysis supporting a rejection under 35 U.S.C. 103 should be made explicit.*" (*id.*). The Court quoting *In re Kahn* (441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006)), stated that

“‘[R]ejections on *obviousness cannot be sustained by mere conclusory statements*; instead, there *must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.*’” (KSR, 550 U.S. at ___, 82 USPQ2d at 1396). The Guidelines provide the following seven rationales:

- (A) Combining prior art elements according to known methods to yield predictable results;
- (B) Simple substitution of one known element for another to obtain predictable results;
- (C) Use of known technique to improve similar devices (methods, or products) in the same way;
- (D) Applying a known technique to a known device (method, or product) ready for improvement to yield predictable results;
- (E) “‘Obvious to try’”—choosing from a finite number of identified, predictable solutions, with a reasonable expectation of success;
- (F) Known work in one field of endeavor may prompt variations of it for use in either the same field or a different one based on design incentives or other market forces if the variations would have been predictable to one of ordinary skill in the art;
- (G) Some teaching, suggestion, or motivation in the prior art that would have led one of ordinary skill to modify the prior art reference or to combine prior art reference teachings to arrive at the claimed invention.

Applicant respectfully submits that the *Office Action fails to provide any articulation, let alone, clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. For example, the *Examiner has not adequately supported the selection of Moshal, Reamer, and the Examiner’s Official Notice to render obvious Applicant’s claimed invention*. The Examiner’s unsupported conclusory statements that “it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the teachings of Moshal by adopting the teachings of Reamer to provide system/method/software, wherein the user is a buyer and the offers comprise asks only from sellers on an approved vendor list (AVL)” and to “one would have been motivated to avoid fraud, maintain business related and facilitate a more efficient experience” *does not adequately provide clear articulation of the reasons why Applicant’s claimed invention would have been obvious*. (6 July 2009 Final Office Action, page 17). In addition, the Examiner’s unsupported conclusory statement *fails to meet any of the Guidelines rationales* to render obvious Applicant’s claimed invention.

Thus, if the Examiner continues to maintain the obvious rejection based on the proposed combination of *Moshal, Reamer*, and the Examiner's Official Notice, *Applicant respectfully requests that the Examiner provide proper support for the obviousness rejection under 35 U.S.C. 103 as necessitated by the Guidelines, including a statement by the Examiner identifying which one of the seven rationales the Examiner is relying on and the proper analysis of that particular rationale, as required by the Guidelines.*

V. **Applicant's Claims are Patentable over the Proposed *Moshal-Reamer-Official-Notice* Combination**

Applicant respectfully submits that independent Claims 30, 38, and 46 are considered patentably distinguishable over the proposed combination of *Moshal, Reamer*, and the Examiner's Official Notice. With respect to dependent Claims 31-37, 39-45, and 47-53: Claims 31-37 depend from independent Claim 30; Claims 39-45 depend from independent Claim 38; and Claims 47-53 depend from independent Claim 46. As mentioned above, each of independent Claims 30, 38, and 46 are considered patentably distinguishable over the proposed combination of *Moshal, Reamer*, and the Examiner's Official Notice. Thus, dependent Claims 31-37, 39-45, and 47-53 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, Applicant respectfully submits that Claims 30-53 are not rendered obvious by the proposed combination of *Moshal, Reamer*, or the Examiner's Official Notice. Applicant further respectfully submits that Claims 30-53 are in condition for allowance. Thus, Applicant respectfully requests that the rejection of Claims 30-53 under 35 U.S.C. § 103(a) be reconsidered and that Claims 30-53 be allowed.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Although Applicant believes no additional fees are deemed to be necessary; the undersigned hereby authorizes the Director to charge any additional fees which may be required, or credit any overpayments, to **Deposit Account No. 500777**. If an extension of time is necessary for allowing this Response to be timely filed, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) to the extent necessary. Any fee required for such Petition for Extension of Time should be charged to **Deposit Account No. 500777**.

Please link this application to Customer No. 53184 so that its status may be checked via the PAIR System.

Respectfully submitted,

8 September 2008
Date

/Steven J. Laureanti/signed
Steven J. Laureanti, Registration No. 50,274

BOOTH UDALL, PLC
1155 W. Rio Salado Pkwy., Ste. 101
Tempe AZ, 85281
214.636.0799 (mobile)
480.830.2700 (office)
480.830.2717 (fax)
steven@boothudall.com

CUSTOMER NO. 53184